

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 1828A)

In re Application of:

Papineau et al.

Serial No.: 10/808,271

Filed: March 23, 2004

For: METHOD AND SYSTEM FOR EXCHANGING
DATA BETWEEN PORTABLE APPLICATIONS
FOR MOBILE DEVICES

Examiner: TBD

Art Unit: TBD

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. 1.47(a)
TO ALLOW ALL AVAILABLE JOINT INVENTORS
TO MAKE APPLICATION ON BEHALF OF INVENTOR WHO REFUSES TO SIGN**


Dear Sir:

Sun Microsystems, Inc. and Sprint.Spectrum LLP, the joint assignees of this application, submit this Petition Under 37 CFR § 1.47(a) requesting permission to allow the two available joint inventors – Scott Papineau and Dana Myers – to make this application on behalf of Jon Bostrom, a joint inventor who refuses to execute the application papers. As proof of Mr. Bostrom's refusal to sign the declaration, Applicants submit the Declaration of Elaine Lee setting forth the circumstances surrounding Mr. Bostrom's refusal. This declaration also includes Mr. Bostrom's last known address.

Along with this petition, Applicants also submit the recently received Notice to File Missing Parts, declarations signed by Mr. Papineau and Mr. Myers, and the requisite fees. If any questions

remain, Applicants' attorney, Brian Harris, may be contacted at his direct dial number of (312) 913-3303

Date: 9/9/04

By: 
Brian R. Harris
Reg. No. 45,900

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive, 31st Floor
Chicago, IL 60606
(312) 913-0001 (phone)
(312) 913-0002 (fax)



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 1828A)

In re Application of:

Papineau et al.

Serial No.: 10/808,271

Filed: March 23, 2004

**For: METHOD AND SYSTEM FOR EXCHANGING
DATA BETWEEN PORTABLE APPLICATIONS
FOR MOBILE DEVICES**

Examiner: TBD

Art Unit: TBD

**DECLARATION OF ELAINE K. LEE IN SUPPORT OF PETITION UNDER 37 CFR 1.47
TO FILE THE APPLICATION ON BEHALF OF NON-SIGNING JOINT INVENTOR JON
BOSTROM**

I, Elaine K. Lee, declare:

1. I am Senior Patent Counsel, IP Law, for Sun Microsystems, Inc. ("Sun Microsystems"). Sprint Spectrum LLP ("Sprint") and Sun Microsystems are the two joint assignees of this application.

2. Jon Bostrom is one of the three joint inventors for this application. Mr. Bostrom was previously employed at Sun Microsystems, and jointly developed the subject matter in this application during his employment with Sun Microsystems. The terms of his employment required that he assign his entire interest in this application to Sun Microsystems. Mr. Bostrom is no longer employed with Sun Microsystems.

3. On August 11, 2004, I contacted Mr. Bostrom via e-mail to discuss obtaining his signature on the declaration for this application and a declaration for another pending patent application also co-owned by Sprint and Sun Microsystems. On August 16, 2004, I sent Mr. Bostrom a copy of all the application papers via Federal

Express. On August 19, 2004, I followed up with Mr. Bostrom via e-mail to discuss obtaining his signature on the declaration.

4. Mr. Bostrom replied that he would not sign the declaration unless he was paid for his signature at a rate of \$1000/hour. Mr. Bostrom estimated that he would require three hours of time to review the two patent applications and sign the declarations. The terms of his employment did not require Sun Microsystems to pay Mr. Bostrom for his participation in the patent process, and Sun Microsystems is under no other obligation to pay Mr. Bostrom in exchange for his signature on the declaration.

5. I declined Mr. Bostrom's offer for payment in exchange for his signature. Mr. Bostrom has not returned the signed declaration, nor has he indicated that he would reconsider his prior offer and sign the declaration without being paid for his services.

6. Copies of my e-mails with Mr. Bostrom are attached to this declaration.

7. Mr. Bostrom's last known address is Jon Bostrom, 755 Yellowpine Road, Reno, NV 89511.

8. I have personal knowledge of the following facts, and if called to testify, I would and could testify competently to the matters set forth herein.

I declare under penalty of perjury that the foregoing is true and correct.

Date: September 1, 2004


Elaine K. Lee

Re: Patent Applications: Sprint-Sun



Subject: Re: Patent Applications: Sprint-Sun
From: jon b <yonnyb@yahoo.com>
Date: Sun, 22 Aug 2004 19:06:33 -0700 (PDT)
To: Elaine.Lee@Sun.COM

I will be taking the paperwork with me on my trip and I will be happy to prioritize my assistance to Sun in this matter should you decide that you want to take advantage of my prior offer.
thanks
jon bostrom

Elaine Lee <Elaine.Lee@Sun.COM> wrote:

Jon,

Thanks for the offer. We will need some time to consider your request. We will contact you after your travels regarding obtaining signature of the inventors' declaration and assignment documents for the two patent applications.

Thank you,
Elaine

Elaine K. Lee
Senior Counsel, IP Law
Sun Microsystems, Inc.
4150 Network Circle, USCA12-101
Santa Clara, CA 94054

Phone 408.404.8994 / x40994
Fax 408.276.7146

jon b wrote:

> Elaine
> I will be traveling for the next three weeks, if you
> could advise today I can make arrangements to expedite
> your request.
> thanks
> jon
> --- jon b wrote:

>
>
>>Elaine
>>my minimum hr fee for t&m for the requested work is
>>usd 1000/hr. I expect a 3 hr block will be required
>>to review. pls advise billing method
>>thanks
>>jon

>>--- Elaine Lee wrote:

>>
>>
>>>Dear Jon,
>>>

>>>>I am writing to you to ask your assistance
>>
>>>regarding
>>
>>>two patent
>>>applications that Sprint filed in March 2003 where
>>>Sun and Sprint
>>>employees were co-inventors. You and Dana Myers
>>>were co-inventors of
>>>the "muglets" technology covered in the patent
>>>applications, along with
>>>Scott Papineau of Sprint. Sprint and Sun are
>>>co-owners of the patent
>>>applications and any resulting patents.
>>>
>>>Could we get your signatures on the Inventors'
>>>Declaration and
>>>Assignment documents for these 2 patent
>>>applications? That will enable
>>>Sprint to get all the necessary documents on file
>>
>>>in
>>
>>>the US patent office.
>>>
>>>We will need your new residence address to include
>>>on the Declaration
>>>document. The address on the current draft shows
>>>"110 N. Chapel Avenue,
>>>Alhambra, CA 91801", which I understand may not
>>
>>>be
>>
>>>correct (Per Dana
>>>Myers, you are now residing in Reno, Nevada?).
>>>
>>>I will be happy to forward the documents to your
>>>residence address for
>>>signature. Just let me know what works best for
>>>you.
>>>
>>>Thanks in advance for your assistance with this
>>>matter.
>>>
>>>Best regards,
>>>Elaine
>>>
>>>--
>>>Elaine K. Lee
>>>Senior Counsel, IP Law
>>>Sun Microsystems, Inc.
>>>4150 Network Circle, USCA12-101
>>>Santa Clara, CA 94054

>>>

>>>Phone 408.404.8994 / x40994

>>>Fax 408.276.7146

>>>

>>>

>>

>>

>